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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,831	12/07/2001	Joseph A. Manico	83565SLP	5035

7590

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Thomas H. Close  
Patent Legal Staff  
Eastman Kodak Company  
343 State Street  
Rochester, NY 14650-4027

EXAMINER
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HANNETT, JAMES M

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/017,831	<b>Applicant(s)</b> MANICO ET AL.	
	<b>Examiner</b> James M. Hannett	<b>Art Unit</b> 2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2005.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,9 and 16-22 is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8,10-15 and 23-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/5/2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 6/17/2005 have been fully considered but they are not persuasive. The applicant argues that the prior art does not teach the use of a "portable" imaging system. The applicant argues that the imaging system of Ueda et al can not be viewed as portable due to the fact that it is too large to be carried by a service provider to a customer's home.

The examiner disagrees with the applicant. The examiner has viewed the claim broadly and views a portable imaging device as a device which is capable of being moved. The claim does not state that the imaging device has to be a size small enough for a service provider to carry the imaging device by hand to a customer's home.

The applicant further argues that the examiner has considered the person who transports the imaging system from a first location to a second location to be the "service provider", and that therefore, the attendant and the transporter must be the same person. The applicant further argues that there is nothing in Ueda et al to support this conclusion.

The examiner does not view the service provider as an individual person. The examiner views the service provider as being the collection of individuals who offer a service. Therefore, the person who transports the imaging system from a first location to a second location and the attendant can be different individuals but both collectively providing a service to the customer.

The applicant argues that the in the prior office action the examiner asserted that it would have been obvious for a photo-shop and a photo processing facility to split fees. The applicant argues that this does not address the claim feature of "a service provider who scans an image at a

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remote site with a portable imaging system receives a credit from a concern that produces an image product”.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a service provider who scans an image at a remote site with a portable imaging system receives a credit from a concern that produces an image product) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The applicant has argued that there is no motivation to combine the teachings of Ueda et al with the teachings of Golasinski et al. The examiner points out that Ueda et al teaches the use of a kiosk that can be placed in a photo-shop. Ueda et al teaches that the kiosk has a credit card reader to allow a user to pay at the kiosk without having to go to a clerk at the register. Golasinski et al teaches on Page 2, Paragraph [0020] that it is advantageous to equip kiosks which allow individuals to pay at the remote location (the kiosk) with optical check readers which can scan a users bank check. This is advantageous because it allows a user to pay with personal check and therefore, increase the payment options to the user.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1: Claims 1, 3, 4, 8, 23 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,429,923 Ueda et al.

2: As for Claim 1, Ueda et al teaches on Column 1, Lines 26-35 and depicts in Figure 1, 2, and 9 a method of digitizing an image, comprising the steps of: The examiner views the process of a company installing the photographic processing apparatus in a photo-shop as a service provider transporting a portable imaging system from a first location to a second location. Ueda et al teaches on Column 36, Lines 43-60 that a customer will enter a photo-shop with photographs, negatives, and PC memory cards, etc with images on them which they want to be developed. This is viewed as the service provider receives the images to be digitized from a user at the second location. Ueda et al teaches on Column 35, Lines 37-42 that the service provider is equipped with a film scanner and a flat bed scanner, therefore the operator in the photo-shop scans the image at the second location (photo-shop) using the portable imaging system to produce a digital image; Ueda et al teaches on Column 36, Lines 55-67 and Column 38, Lines 1-9 that the photo-shop operator will take credit card information and order request information from a customer, this is viewed as the service provider receives an order request associated with the digital image from the user. Furthermore, Ueda et al depicts in Figure 9 and teaches on Column 71, Lines 10-50 that if the photo-shop is unable to perform all of the desired imaging services the images can be transmitted to the main photo-finishing center or a truck will arrive at the photo-shop and pickup the images and bring them to the photo-finishing processing center. This is viewed as the service provider providing the digital images to a fulfiller (photo-finishing center) for fulfillment of the order request.

3: As for Claim 3, Ueda et al teaches on Column 36, Lines 55-67 and Column 38, Lines 1-9 that the photo-shop operator will take credit card information for receiving payment from the user.

4: In regards to Claim 4, Ueda et al teaches on Column 36, Lines 55-67 and Column 38, Lines 1-9 the step of receiving payment from the user is accomplished by inputting credit card information to the portable imaging system.

5: In regards to Claim 8, Ueda et al teaches on Column 1, Lines 26-35 and depicts in Figure 1, 2, and 9 a method of collecting a digitized image, comprising the steps of: Ueda et al teaches on Column 36, Lines 43-60 that a customer will enter a photo-shop with photographs, negatives, and PC memory cards, etc with images on them which they want to be developed. This is viewed as a user providing the digitized image to the service provider at a predetermined location. Furthermore, Ueda et al depicts in Figure 9 and teaches on Column 71, Lines 10-50 that if the photo-shop is unable to perform all of the desired imaging services the images can be transmitted to the main photo-finishing center. This is viewed as the service provider copying the digitized image at the predetermined location (photo-shop) using a portable kiosk and providing the digital images to a fulfiller (photo-finishing center) for fulfillment of the order request.

6: As for Claim 23, Claim 23 is rejected for reasons discussed related to Claim 1.

7: As for Claim 25, Claim 25 is rejected for reasons discussed related to claim 1.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**16:** Claims 6, 10-15, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,429,923 Ueda et al.

**17:** In regards to Claim 6, Ueda et al teaches a system and method which allows a user to go to a photo-store and give a store operator images, negatives, and memory with images stored on them. Ueda et al further teaches that a store operator will transmit the electronic images to a remote photo-finishing processing facility or call to have a truck from the photo-processing facility come to pickup the images to be processed. Ueda et al further teaches that the clerk in the photo-shop will take down the customers order request information and credit card information for payment. However, Ueda et al is silent as to who receives the payment and does not teach that the service provider (photo-shop) receives a credit from the photo-finishing center for some of the fee associated with producing an image product associated with the order request by agreeing to use the portable imaging system.

Official notice is taken that it was common practice in the art at the time the invention was made for a convenience store which collects film cartridges and the processing facility which the store sends the film cartridges to in order to be developed, split the fee paid by the customer so that both parties can get paid.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to split the fee paid by the customer between the photo-shop and the photo processing facility so that both parties can get paid, and therefore stay in business.

**18:** In regards to Claim 10, Ueda et al teaches on Column 1, Lines 26-35 and depicts in Figure 1, 2, and 9 a method of digitizing an image provided by a user comprising the steps of:

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The examiner views the process of a company installing the photographic processing apparatus in a photo-shop as a service provider transporting a portable imaging system to a first location. Ueda et al teaches on Column 36, Lines 43-60 that a customer will enter a photo-shop with photographs, negatives, and PC memory cards, etc with images on them which they want to be developed. This is viewed as the service provider receives the images to be digitized from a user at the first location. Ueda et al teaches on Column 35, Lines 37-42 that the service provider is equipped with a film scanner and a flat bed scanner, therefore the operator in the photo-shop scans the image at the first location (photo-shop) using the portable imaging system to produce a digital image; Furthermore, Ueda et al depicts in Figure 9 and teaches on Column 71, Lines 10-50 that if the photo-shop is unable to perform all of the desired imaging services the images can be transmitted to the main photo-finishing center. This is viewed as the service provider providing the digital images to a fulfiller (photo-finishing center) for fulfillment of the order request. Ueda et al teaches on Column 36, Lines 55-67 and Column 38, Lines 1-9 that the photo-shop operator will take credit card information and order request information from a customer, this is viewed as the service provider receives an order request associated with the digital image from the user. However, Ueda et al is silent as to who receives the payment and does not teach that the service provider (photo-shop) receives a credit from the photo-finishing center for some of the fee associated with producing an image product associated with the order request by agreeing to use the portable imaging system.

Official notice is taken that it was common practice in the art at the time the invention was made for a convenience store which collects film cartridges and the processing facility



which the store sends the film cartridges to in order to be developed, split the fee paid by the customer so that both parties can get paid.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to split the fee paid by the customer between the photo-shop and the photo processing facility so that both parties can get paid, and therefore stay in business.

19: As for Claim 11, Ueda et al teaches on Column 1, Lines 26-35 and depicts in Figure 1, 2, and 9 a method of producing an image product from an image comprising the steps of:

The examiner views the process of a company installing the photographic processing apparatus in a photo-shop as a service provider transporting a portable imaging system from a first location to a predetermined location (photo-shop); Ueda et al teaches on Column 36, Lines 43-60 that a customer will enter a photo-shop with photographs, negatives, and PC memory cards, etc with images on them which they want to be developed. This is viewed by the examiner as the service provider receiving the image from a user at the predetermined location (photo-shop);

Ueda et al teaches on Column 35, Lines 37-42 that the service provider is equipped with a film scanner and a flat bed scanner. Therefore the operator in the photo-shop scans the image at the predetermined location (photo-shop) using the portable imaging system to produce a digital image; Furthermore, Ueda et al depicts in Figure 9 and teaches on Column 71, Lines 10-50 that if the photo-shop is unable to perform all of the desired imaging services the images can be transmitted to the main photo-finishing center. This is viewed as the service provider providing the digital images to a fulfiller (photo-finishing center) for fulfillment of the order request.

Ueda et al teaches on Column 36, Lines 55-67 and Column 38, Lines 1-9 that the photo-shop operator will take credit card information and order request information from a customer, this is

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viewed as the service provider receives an order request associated with the digital image from the user. However, Ueda et al is silent as to who receives the payment and does not teach that the service provider (photo-shop) receives a credit from the photo-finishing center for some of the fee associated with producing an image product associated with the order request by agreeing to use the portable imaging system.

Official notice is taken that it was common practice in the art at the time the invention was made for a convenience store which collects film cartridges and the processing facility which the store sends the film cartridges to in order to be developed, split the fee paid by the customer so that both parties can get paid.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to split the fee paid by the customer between the photo-shop and the photo processing facility so that both parties can get paid, and therefore stay in business.

20: In regards to Claim 12, The photo-finishing center is viewed by the examiner as the fulfiller.

21: As for Claim 13, Ueda et al depicts in Figure 9 and teaches on Column 71, Lines 10-50 that if the photo-shop is unable to perform all of the desired imaging services the images can be transmitted to the main photo-finishing center. Therefore, the image product is produced at the second location (photo-finishing center) remote from the predetermined location (photo-store).

22: In regards to Claim 14, Ueda et al teaches on Column 35, Lines 37-42 that the service provider is equipped with a film scanner and a flat bed scanner. Therefore the operator in the photo-shop scans the image at the predetermined location (photo-shop) using the portable imaging system to produce a digital image.

23: As for Claim 15, Ueda et al teaches on Column 36, Lines 43-60 that a customer will enter a photo-shop with photographs, negatives, and PC memory cards, etc with images on them which they want to be developed.

24: In regards to Claim 24, Claim 24 is rejected for reasons discussed related to claim 11.

**27:** Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,429,923 Ueda et al in view of US 2003/0097332 Golasinski et al.

28: As for Claim 5, Ueda et al teaches the claimed invention as discussed in Claim 3. Furthermore, Ueda et al teaches that the portable system as depicted in Figure 2 includes a scanner to scan images. Ueda et al teaches that payment can be received by reading a users credit card, however, does not teach that a user can make a payment by scanning a user check using the scanner.

Golasinski et al teaches in the abstract and on Page 2, Paragraph [0020] that it is advantageous to equip kiosks at remote locations with optical check readers which can scan a users financial institution issued check so that a user can pay using a personal check and therefore, increase the payment options to the user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to equip the photo-processing system of Ueda et al with the check scanning system of Golasinski et al so that a user can pay using a personal check and therefore, increase the payment options to the user.

***Allowable Subject Matter***

**29:** Claims 2, 9 and 16-22 are allowed

The following is a statement of reasons for the indication of allowable subject matter:

The prior art does not teach the method of transporting a portable imaging system to a first location; receiving a hardcopy document from a user at the first location, the hard copy document containing the visual image; scanning the hard copy document at the first location using the portable imaging system to produce a digital image; and transporting the portable imaging system to a second location remote from the first location. Furthermore, the prior art does not teach the method of sequentially transporting a portable imaging system from a first location; accessing the image to be digitized at the second location; scanning the image at the second location using the portable imaging system and storing the digital image in memory disposed in the portable imaging system and generating an order request associated with the stored digital image.

### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M. Hannett whose telephone number is 571-272-7309.

The examiner can normally be reached on 8:00 am to 5:00 pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James M. Hannett  
Examiner  
Art Unit 2612

JMH  
September 1, 2005



THAI TRAN  
PRIMARY EXAMINER